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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,262	11/23/2001	Junji Shinohara	2038-280	2417

7590 03/26/2003
LOWE HAUPTMAN GILMAN & BERNER, LLP
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EXAMINER

GRAYSON, ANGELA J

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

Office Action Summary

Application No.

09/990,262

Applicant(s)

SHINOHARA ET AL.

Examiner

Angela J. Grayson, Esq.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Application filed 11-23-2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, page 22 lines 5 and 11 disclose, "first both side portions" and "second both side portions" respectively. It is unclear what structural features the Applicant is disclosing. Clarification and correction are required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,188,627 to Igue of Patent Abstracts of Japan.

As to claim 1, Igue discloses a disposable undergarment comprising topsheet, backsheet, and core (Figure 3 members 11, 14, and 13), front and back waist regions (members 9 and 10), and a crotch region (Figure 3); the crotch region being formed along parts of both side edge portions there of transversely opposite side edge portions curving inward transversely (Figure 3) of the diaper and defining peripheral edge portions of leg-openings (member 8) and provided under a stretchable first elastic

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member attached under tension (member 5B; col. 3 lines 16-25 disclosing elastic bonded under stretched conditions) thereto so as to extend in a circular arc from a vicinity of front ends of said transversely opposite side edge portions toward a longitudinally middle zone of the crotch region and a stretchable second elastic member attached thereto (Figure 3 5A) so as to extend in a circular arc from a vicinity of rear ends of said transversely opposite side edge portions toward said longitudinally middle zone of said crotch region, said undergarment further comprising said core being placed substantially in the crotch region (Figure 3 member 14) and including a middle zone extending in the longitudinal middle zone of the crotch region, a front end zone extending from the middle zone toward the front waist region and a rear end zone extending from the middle zone toward the rear waist region (Figure 3 member 14 in the regions of 9 and 10); said first elastic member including both side portions extending in the vicinity of the front ends of the transversely opposite side edge portions and a first middle portion and first middle portion extending on a side of said backsheet across the front end zone of said core (Figure 3 members 5B and 13); said second elastic member including second both side portions extending in the vicinity of the rear ends of said transversely opposite side edge portions and a second middle portion extending on the side of the backsheet across the rear end zone of the core (members 5A, 13).

As to claim 2, Igue discloses an undergarment wherein the stiffness of the core is lower in the front and rear end zones than in the middle zones. (From Figure 3 it is disclosed the elastic elements reside in the middle zone of the core and attached by

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adhesive, inherently making this area of the core more stiff compared to the front and rear zones which are free of elastic and adhesive).

As to claim 3, Igue discloses an undergarment wherein between the first middle portion of the first elastic member and the second middle portion of the second elastic member, third elastic members are attached under tension to the undergarment so as to extend in the longitudinal direction along the transversely opposite side edge portions (Figure 3 members 5B1, 5A1; col. 3 lines 16-25 disclosing elastic bonded under stretched conditions).

Double Patenting

5. The nonstatutory obviousness-type double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. US Patent No. 09/990,263. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of 09/90,263 recites the additional limitation of having the third elastic members extend along

transversely opposite side edge portions forming circular arcs which are convex inward, since it would have been an obvious matter of design choice to modify the third elastic members of the instant case to include the convex inward design of '263, since such a modification would have involved a mere change in the form or shape of a component. A change in form or shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Nos 6,464,677; 6,201,386; 6,013,065.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela J. Grayson, Esq. whose telephone number is 703-305-1806. The examiner can normally be reached on Monday-Thursday from 9:30 am to 7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on 703-305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

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Angela J. Grayson 
March 20, 2003


A. Vanatta
Primary Examiner